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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,895	12/19/2001	Jani Pirkola	413-010762-US(PAR)	3213
2512	7590	03/09/2006	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			RAMOS FELICIANO, ELISEO	
			ART UNIT	PAPER NUMBER
			2687	

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,895

Applicant(s)

PIRKOLA ET AL.

Examiner

Eliseo Ramos-Feliciano

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 14, 2005 has been entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claim 21** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding *claim 21*, the claimed software means (computer program product) is non-statutory subject matter since it is not a process, machine, manufacture nor composition of matter; nor it is recorded on some computer-readable medium, see MPEP 2106(IV)(B)(1).

Claim Objections

4. **Claim 21** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim does not include every limitation of the claim from which it depends because the claim does not require steps to be performed nor limits the claim to a particular structure.

Art Unit: 2687

5. **Claims 1-22** are objected to because of the following informalities: the format of the claims is non standard and awkward. Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(i). There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP 608.01(i)-(p). Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1-22** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claims 1, 4, 9, 14, and 16**, the language of the claims is awkward. For each one, the full claim appears to be the preamble leaving no body with active limitations. No clear distinction between the preamble and the body of the claim. For examination on the merits the claim will be interpreted as best understood.

NOTE: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on a separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP 608.01(i)-(p).

NOTE: A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the

Art Unit: 2687

claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

As to **claims 2-3, 5-8, 10-13, 15, 17-22**, they depend from claims 1, 4, 9, 14, and 16; therefore, they contain same problem explained above. For examination on the merits the claim(s) will be interpreted as best understood.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 1-3, 7-12, and 14-22** are rejected under 35 U.S.C. 102(e) as being anticipated by Tuomela et al. (US Patent Application Publication US-2001/0031633-A1).

Regarding **claim 1**, *in view of 35 USC 112 rejection explained above*, Tuomela et al. discloses a method for establishing and making a check for a communications connection, in which method an electrical communications connection is set up between one of a plurality of calling parties and a receiving party (Figure 2), the method comprising a step of establishing a context-based file arrangement comprising an activity status server (WAP server 7, Figure 2) and a plurality of activity logs connected to the server, the activity logs being in communication with the phones of respective ones of the calling parties (see paragraph 0019, and claim 5 of Tuomela et al.);

in which method before establishing the communications connection proper, there is a making of a check, via communication with the file arrangement, for the calling party concerning the ability of the receiving party to receive a message (call) sent by the calling party and, (“check context information”, see Figure 2, element 2; see also page 1, paragraph 0010)

based on that information, there is a making of a decision about the establishment of the communications connection proper. (for example: a decision is made between leaving a message for the user, or causing the call to ring the user’s phone, see page 1, paragraph 0008, especially the last three lines; and the abstract).

The “context information” indicates a receiving party’s activity, place or location and/or environment; see pages 1-2, paragraphs 0015-0016 and 0019.

Regarding **claim 2**, Tuomela et al. discloses everything claimed as applied above (see *claim 1*). In addition, Tuomela et al. discloses that the check for the calling party concerning the ability of the receiving party to receive the message (call) of the calling party includes steps of:

dialing the receiving party's number, (Figure 2, element 1)

fetching the activity status data of the receiving party (context information) from an activity log (at WAP context server 7), (Figure 2, element 2; page 1, paragraphs 0009-0010)

presenting possible options of action (page 2, paragraphs 0024-0031) and selecting the best of them ("preferred selection"), (page 2, paragraphs 0022 and 0033)

examining whether the option of action is possible, and (The list presented to the calling party, shown in paragraphs 0026-0031, are “possible” options. It is the calling party who “examines” these options.)

the communications connection proper is established if the option of action is found possible. (If the calling party chooses, for example, “put the call through now”, paragraph 0031, then the proper communications connection is established.)

Regarding **claim 3**, Tuomela et al. discloses everything claimed as applied above (see *claim 2*). In addition, Tuomela et al. discloses that the data (context information) representing the activity status of the receiving user are fetched from an activity status server (WAP server 7; Figure 2). (See paragraphs 0009 and 0019.)

Regarding **claim 7**, Tuomela et al. discloses everything claimed as applied above (see *claim 1*). In addition, Tuomela et al. discloses that the communications connection proper is a telephone connection (“phone call” - Figure 2, element 1; “incoming call” - abstract, line 4).

Regarding **claim 8**, Tuomela et al. discloses everything claimed as applied above (see *claim 1*). In addition, Tuomela et al. discloses that the communications connection proper is a text message (“SMS message”, “e-mail” - paragraph 0036, lines 4-5).

Regarding **claim 9**, *in view of 35 USC 112 rejection explained above*, Tuomela et al. discloses a communications connection set-up and checking arrangement for a plurality of calling parties and a receiving party (Figure 2), comprising a terminal of one calling party of the plurality of calling parties (left-side 10, Figure 2), a terminal of the receiving party (right-side 10, Figure 2) and an electrical communications connection between the two parties (call), which arrangement further comprises user-specific activity logs (“context information”) (See paragraphs 0009-0010, 0015-0016, 0019, and claim 1 of Tuomela et al.);

wherein the communications connection includes a context-based file arrangement comprising an activity status server and said plurality of activity logs connected to the server, the

activity logs being in communication with the phones of respective ones of the calling parties to enable a checking before establishing a communication connection with a receiving party (see WAP server 7, Figure 2) (see paragraph 0019, and claim 5 of Tuomela et al.).

Regarding **claim 10**, Tuomela et al. discloses everything claimed as applied above (see *claim 9*). In addition, Tuomela et al. discloses wherein the activity status server is separate from phones of respective ones of the calling parties (WAP server 7, Figure 2) (See paragraph 0019, and claim 5 of Tuomela et al.).

Regarding **claim 11**, Tuomela et al. discloses everything claimed as applied above (see *claim 9*). In addition, Tuomela et al. discloses that the activity logs are files in the activity status server (Since it is stored in a storage unit it is a “file” as claimed; see paragraph 0009. The WAP-based message is transferred from WAP server 7 to caller’s phone equipment; see paragraphs 0013 and 0008. See also, e.g., claim 10 of Tuomela et al.).

Regarding **claim 12**, Tuomela et al. discloses everything claimed as applied above (see *claim 9*). In addition, Tuomela et al. discloses that the activity log is a file in the terminal of the user (context information is stored in the user’s phone. See paragraph 0009, and claim 4 of Tuomela et al. Since it is stored in a storage unit it is a “file” as claimed).

Regarding **claim 14**, *in view of 35 USC 112 rejection explained above*, Tuomela et al. discloses a cellular network (Figure 3) comprising terminals (MS 10), base stations (BTS 5), base station controllers (BSC 4) and switching centers (MSC 3), which network further comprises an activity status server (WAP SERVER 7) for storing a user-specific activity log. (See paragraphs 0034 and 0019). The cellular network serving as a communications connection set-up and checking arrangement for a plurality of calling parties and a receiving party (Figure

Art Unit: 2687

2), the communications connection set-up and checking arrangement comprising a terminal of one calling party of the plurality of calling parties (left-side 10, Figure 2), a terminal of the receiving party (right-side 10, Figure 2) and an electrical communications connection between the two parties (call), which arrangement further comprises activity logs ("context information") (See paragraphs 0009-0010, 0015-0016, 0019, and claim 1 of Tuomela et al.);

wherein the communications connection includes a context-based file arrangement comprising an activity status server and said plurality of activity logs being in communication with the server, the activity logs being in communication with the phones of respective ones of the calling parties to enable a checking before establishing a communication connection with a receiving party (see WAP server 7, Figure 2) (paragraph 0019, and claim 5 of Tuomela et al.).

Regarding **claim 15**, Tuomela et al. discloses everything claimed as applied above (see *claim 14*). In addition, Tuomela et al. discloses that the activity status server (7) is connected with a switching center (3). (See Figure 3).

Regarding **claim 16**, *in view of 35 USC 112 rejection explained above*, Tuomela et al. discloses a cellular network terminal (MS 10) comprising a means for entering data (keypad 16) in the terminal, data display means (display 14), data transmission means (transmitter 20), data reception means (receiver 22), memory unit (memory 13) and a control unit (MCU 12), which terminal further comprises an activity status monitoring means (CSU 26). (See Figure 3, paragraphs 0037-0040, and 0015). Wherein the terminal is operative upon connection with a cellular network, the cellular network serving a plurality of calling parties and a receiving party (Figure 2), wherein the terminal serves one calling party of the plurality of calling parties (left-side 10, Figure 2), wherein the network includes an activity status server (WAP server 7, Figure

Art Unit: 2687

2) of a context-based file arrangement, and said activity status monitoring means is in communication with the activity status server to enable a checking before establishing a communication connection with a receiving party (See paragraphs 0009-0010, 0015-0016, 0019, and claim 1 of Tuomela et al.).

Regarding **claim 17**, Tuomela et al. discloses everything claimed as applied above (see *claim 16*). In addition, Tuomela et al. discloses that part of the memory (13) of the terminal can be allocated for creating and maintaining a user-specific activity log (“current context”). (See paragraph 0038).

Regarding **claim 18**, Tuomela et al. discloses everything claimed as applied above (see *claim 16*). In addition, Tuomela et al. discloses that part of a SIM card (“removable SIM”), connected with the terminal, can be allocated for creating and maintaining a user-specific activity log (“subscriber-related information”). (See paragraph 0038).

Regarding **claim 19**, Tuomela et al. discloses everything claimed as applied above (see *claim 16*). In addition, Tuomela et al. further discloses means for displaying (14) activity status data for the receiving party fetched from an activity status server (WAP server 7). (See paragraphs 0024-0025 and 0019).

Regarding **claim 20**, Tuomela et al. discloses everything claimed as applied above (see *claim 19*). In addition, the mode or means employed by the user to activate or enable context-sensitive answering read as the claimed “means for making a decision about whether a communications connection proper will be established” because when enabled it “makes a decision about” whether to establish the proper communications connection. (See paragraphs 0016-0017).

Regarding **claim 21**, Tuomela et al. discloses everything claimed as applied above (see *claim 1*). The process of creating a context-based data is inherently performed by “software means” or, simply, software (e.g. see “operating program”, paragraph 0038). Which software means is arranged so as to realize the steps of the method according to *claim 1* (explained above).

Regarding **claim 22**, Tuomela et al. discloses everything claimed as applied above (see *claim 21*). In addition, the application program (operating program) is stored on a data transfer medium, in the memory (13) of a terminal, on a SIM card of a terminal, or in a cellular network device. (See paragraph 0038).

10. **Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuomela et al. (US Patent Application Publication US-2001/0031633-A1).

Regarding **claim 13**, Tuomela et al. discloses everything claimed as applied above (see *claim 9*). In addition, Tuomela et al. further discloses an user profile editing function (the user can input or “edit” current context information by means of a keypad 16; paragraph 0008, lines 8-10, paragraph 0015, last three lines, paragraph 0040, lines 3-4, and claim 3 of Tuomela et al., inter alia) and an activity status application function (“operating program”, paragraph 0038).

However, Tuomela et al. fails to specifically disclose an activity status decoding function as claimed.

Tuomela et al. teaches that the activity status (current context information) is transferred to the calling party (caller’s phone) in the form of a code that identifies one of a set of animations stored in the caller’s phone for selecting an appropriate one to be displayed to the caller (paragraph 0018, lines 14-18). The animation can depict the current activity of the called party

Art Unit: 2687

(receiving party), for example, in a meeting, on a train, etc. (paragraph 0018, lines 8-10). Thus, Tuomela et al. suggests “an activity status decoding function” as claimed because the transferred code is matched with an appropriate animation. One advantage of this is that animations can be language independent (paragraph 0018, lines 12-13).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide Tuomela et al. with “an activity status decoding function” because it would enable a language independent feature as suggested by the same Tuomela et al.

11. **Claims 4-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuomela et al. (US Patent Application Publication US-2001/0031633-A1) in view of Silverman (US Patent Number 6,035,031).

Regarding **claim 4**, *in view of 35 USC 112 rejection explained above*, Tuomela et al. discloses a method for establishing and making a check for a communications connection, in which method an electrical communications connection is set up between one of a plurality of calling parties and a receiving party (Figure 2), the method comprising a step of establishing a context-based file arrangement comprising an activity status server (WAP server 7, Figure 2) and a plurality of activity logs connected to the server, the activity logs being in communication with the phones of respective ones of the calling parties (see paragraph 0019, and claim 5 of Tuomela et al.);

in which method before establishing the communications connection proper, there is a making of a check, via communication with the file arrangement, for the calling party concerning the ability of the receiving party to receive a message (call) sent by the calling party and, (“check context information”, see Figure 2, element 2; see also page 1, paragraph 0010)

based on that information, there is a making of a decision about the establishment of the communications connection proper. (for example: a decision is made between leaving a message for the user, or causing the call to ring the user's phone, see page 1, paragraph 0008, especially the last three lines; and the abstract).

The "context information" indicates a receiving party's activity, place or location and/or environment; see pages 1-2, paragraphs 0015-0016 and 0019.

In addition, Tuomela et al. discloses that the check for the calling party concerning the ability of the receiving party to receive the message (call) of the calling party includes steps of:

dialing the receiving party's number, (Figure 2, element 1)

fetching the activity status data of the receiving party (context information) from an activity log (at WAP context server 7), (Figure 2, element 2; page 1, paragraphs 0009-0010)

presenting possible options of action (page 2, paragraphs 0024-0031) and selecting the best of them ("preferred selection"), (page 2, paragraphs 0022 and 0033)

examining whether the option of action is possible, and (The list presented to the calling party, shown in paragraphs 0026-0031, are "possible" options. It is the calling party who "examines" these options.)

the communications connection proper is established if the option of action is found possible. (If the calling party chooses, for example, "put the call through now", paragraph 0031, then the proper communications connection is established.)

However, Tuomela et al. fails to specifically disclose that if the option of action decided upon (e.g. call) is impossible to carry out, there is a step of checking whether the option of action can be carried out later.

Silverman discloses method wherein if the option of action decided upon (call) is impossible to carry out, it is checked whether the option of action can be carried out later (call-back). If the call is impossible to carry out “it is checked whether” a call-back can be carried out later. See column 3, lines 11-30 of Silverman.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Tuomela et al., if the option of action decided upon is impossible to carry out, so as to check whether the option of action can be carried out later, because this would enable the users to communicate in spite of present unavailability of the called party.

Regarding **claim 5**, Tuomela et al. and Silverman disclose everything claimed as applied above (see *claim 4*). However, they fail to specifically disclose that if the option of action can be carried out later, the data representing the activity status of the receiving party are fetched again after a time delay.

Silverman discloses to perform the call-back within a time delay (timer value); see column 3, lines 30-50. The call-back includes making a phone call to the called party (receiving party); column 3, lines 61-62.

Tuomela et al. discloses that upon a phone call (Figure 2, element 1 of Tuomela et al.), the activity status (context information) of the receiving party are fetched (Figure 2, element 2 of Tuomela et al.). Which in combination with Silverman’s call-back is “fetched again after a time delay”.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Tuomela et al., if the option of action can be carried out later,

Art Unit: 2687

so that the data representing the activity status of the receiving party are fetched again after a time delay, because this would provide the calling party with updated information about the called party since the time elapsed from the first original call to a second successful call can be significant.

Regarding **claim 6**, Tuomela et al. and Silverman disclose everything claimed as applied above (see *claim 4*). However, Tuomela et al. fails to specifically disclose that if the option of action decided upon cannot be carried out after a time delay, a communications connection proper is not established.

Silverman further discloses that if the option of action decided upon (call-back) cannot be carried out after a time delay (timer value), a communications connection proper is not established. For example, the call-back timer value can be set to 30 minutes. If the timer value expires the call-back is terminated and the communications connection proper is not established. See column 3, lines 35-45 of Silverman.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Tuomela et al., if the option of action decided upon cannot be carried out after a time delay, so that a communications connection proper is not established, because the wait is too long after the time delay (timer) expires.

Response to Arguments

12. Applicant's amendment of the claims enlightened Examiner's new interpretation of the claims and made the claims clearly open to rejection based on new interpretation of the amended claims. Therefore, Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Art Unit: 2687

13. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 571-272-7925. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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ELISEO RAMOS-FELICIANO
PRIMARY EXAMINER

ERF/erf

March 6, 2006